

**REMARKS**

***Status of Application***

Claims 1-10 and 14-23 are all the claims pending in the application. Claim 24 is canceled without prejudice or disclaimer.

***Claim Rejections Under 35 U.S.C. § 112***

Claim 24 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claim 24 is canceled, thereby rendering the rejection moot. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

***Claim Rejections Under 35 U.S.C. § 103***

**Anderson in view of Taira**

Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,778,205 to Anderson et al (“Anderson ‘205”) in view of U.S. Patent No. 5,809,003 to Taira et al. (“Taira”). Applicant traverses this rejection for at least the following reasons.

As an initial matter, although the Taira reference is newly cited in the instant Office Action, the Examiner has made the instant Office Action final. Applicant respectfully notes that an Office Action may not be made final where it cites a new reference or new grounds of rejection not necessitated by Applicant’s amendment. Accordingly, Applicant respectfully requests that the Examiner withdraw the finality of the present Office Action.

In the “Response to Arguments” section of the instant Office Action, and in the Examiner’s discussion of the rejection of claims 1, 4, and 5, the Examiner contends that Taira discloses adhering a labeling layer to a disk by a lamination process. The Examiner cites col. 7,

lines 51-55, and Fig. 5A of Taira as allegedly teaching this feature of claim 1. The cited portion of Taira states that “the third embodiment is advantageous in mass production since it does not require any particular manufacturing process except for the disk lamination process, to include label information in a disk.” (Taira at col. 7, lines 51-55.)

The Examiner concedes that Anderson does not teach the lamination of the labeling layer, and cites Taira in an attempt to make up the deficiency. As a motivation to combine, the Examiner contends that adhesive labeling allows secure attachment by a simple process. Both of these bases are insupportable, as the Anderson reference specifically criticizes adhesion for its lack of security and difficulty in use. (See Anderson at col. 1, lines 45-61.) Anderson, thus, teaches away from any adhesion or lamination, to the extent such might be suggested in Taira.

The Examiner has also failed to rebut the previously submitted argument that a phase change writing as contemplated by Anderson is not inherently rewritable.

Assuming, arguendo, that the references could be combined, the references still would not teach all features of claim 1. As shown in Fig. 4 of Taira, and discussed in col. 7 of that reference, the third embodiment of Taira “is directed to a case where data are recorded on both surfaces, and not all areas of the surfaces are full of data.” (Taira at col. 7, lines 8-10.) The third embodiment does not, in fact, teach the use of a labeling layer or indication layer. The third embodiment of Taira, rather, appears to teach only that two resin substrates are laminated together, both substrates being designed for the recording of data. The embodiment merely appears to use a portion of one of the resin substrates to record data which may appear on the surface of the disk as a label visible to a user.

For example, col. 7, lines 11-15 reads as follows:

label information is provided by forming pits or grooves in an area in which no data is recorded beforehand. This differs from the second embodiment wherein the donut-shaped sheet with label information printed thereon is inserted between the disks.

Furthermore, col. 7, lines 32-37 reads as follows:

In this embodiment, pits 16 corresponding to record data are formed in the overall surface of the resin substrate 11A. On the other hand, in the resin substrate 11B, grooves 18A indicative of label information is formed in an outer circumference portion thereof, as well as pits 16 corresponding to record data.

Thus, it is clear that Taira merely discloses laminating two data layers together, namely the resin substrates, and does not disclose laminating a labeling or indication layer. The data layers disclosed in col. 7 of Taira cannot be construed as labeling layers, since a layer is only partially used for labeling, and also includes data; the label is, in fact, written into the layer as "grooves 18A," making it clear that the resin substrates of the third embodiment of Taira are not labeling layers.

Thus, Anderson '205 and Taira, alone or in combination, fail to teach or suggest each and every element of independent claim 1. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1 and its dependent claims 4 and 5.

**Anderson in view of Taira and Nakano**

Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of Taira, and further in view of U.S. Patent Publication No. 2001/0008872 to Nakano ("Nakano"). Applicant traverses this rejection for at least the following reasons.

In the "Response to Arguments" section of the instant Office Action, the Examiner contends that substituting electronic paper in place of the writable label of Anderson '205 "is

well within the scope of knowledge that is known to one of ordinary skill in the art because the substitution results in a predictable result.”

The Examiner’s assertion that the substitution results in a predictable result still does not provide a motivation to combine Anderson ‘205 and Taira in view of Nakano. The alleged motivation previously supplied by the Examiner, namely, “to provide a clearly viewable image or text on the indication layer,” as stated on page 7 of the instant Office Action, was rebutted in the Amendment of December 28, 2007. In that Amendment, Applicant stated that “Anderson already provides a visible indication via thermal changes in a dye. Therefore, the Examiner’s proffered reason for the combination is not supportable.” (Citations omitted).

It is further noted that Nakano contemplates a type of layer adhesion that Anderson simply denounces for the reasons discussed above for claim 1. This teaching away, so unambiguously stated, cannot support the prior art rejection. To ignore such a teaching away would be tantamount to hindsight reconstruction whereby the only reason the Examiner is combining the references is to provide an unsupported basis for unpatentability. Applicant submits that the rejection should, therefore, be withdrawn.

Furthermore, if the Examiner intends to assert that one of ordinary skill in the art would have known methods of combining the matter of Anderson ‘205 and Nakano so as to teach the matter of claim 2, and that the results would have been predictable at the time of invention, the Examiner has failed to make the requisite factual findings as set forth in MPEP § 2143[A].

Thus, for at least the above reasons, the Examiner’s statements are insufficient to support a prima case of obviousness. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

**Anderson in view of Araki**

Claims 3, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of U.S. Patent Publication No. 2003/0103762 to Araki et al. ("Araki"). Applicant traverses this rejection for at least the following reasons.

The Examiner contends that the combination of Anderson '205 in view of Araki is proper because "the substitution results in a predictable result." However, the Examiner has not responded to the detailed arguments set forth in the Amendment of December 28, 2007 with respect to the Examiner's purported motivation to combine these references. For example, Applicant stated that "Anderson '205 appears to be capable of providing a 'visible image' on the laser writable label side of the optical data storage disk without the addition of any further references, such as Araki." (Amendment of December 28, 2007 at 10.) Furthermore, Applicant provided examples of further untaught modifications which would be required in order to reach the invention of claim 3, showing that a substantial reconstruction and redesign of the elements would be required. Applicant further pointed out that because of the untaught modifications which would be required, it is not clear that one of ordinary skill in the art would be successful in making such a combination.

The Examiner's assertion that "the substitution results in a predictable result," is contrary to the examples and explanation provided by Applicant in the above-described portion of the Amendment of December 28, 2007. Since the clear issues raised by Applicant have not been addressed by the Examiner, the Examiner's conclusory assertion that the substitution results in a predictable result fails to rise to the level of a motivation sufficient to support a prima facie case of obviousness.

Furthermore, if the Examiner intends to assert that one of ordinary skill in the art would have known methods of combining the matter of Anderson '205 and Araki so as to teach the matter of claim 3, and that the results would have been predictable at the time of invention, the Examiner has failed to make the requisite factual findings as set forth in MPEP § 2143[A].

Thus, for at least the above reasons, the Examiner's statements are insufficient to support a prima case of obviousness. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 3, 22, and 23.

**Anderson '205 in view of Anderson '586**

Claims 6, 7, 9, 10, 14-19, 21, 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of U.S. Patent No. 7,145,586 to Anderson et al. ("Anderson '586"). Applicant traverses this rejection for at least the following reasons.

Claim 6 recites the following:

A detecting section detecting a difference between storage data which is stored at the storage layer of the recording medium, and new data which is to be subsequently stored.

In the "Response to Arguments" section of the instant Office Action, the Examiner contends that this element of claim 6 is taught by Anderson '586 at col. 6, lines 9-29. This portion of Anderson '586 states that "information related to the data side of an optical disk is determined. This can include determining . . . the list of files that are or will be stored on the data side of the optical disk."

The Examiner appears to contend that the system of Anderson '586 must inherently detect a difference between stored data and new data when new data is recorded. However, this is not necessary. For example, a user may provide new data while indicating that the data is

new; in this case, there would be no inherent need for Anderson '586 to "detect[] a difference" as claimed.

The cited portion of Anderson '586 only appears to state that the system can determine the list of files that are on the data side of the optical disk, and can also determine the list of files that will be stored on the data side of the optical disk. The cited portion of Anderson '586, however, does not describe making a comparison between the data that are stored and the data that will be stored, and does not describe determining or detecting a difference between them. Thus, according to the cited description in col. 6, Anderson '586 does not necessarily "detect[] a difference between storage data which is stored . . . and new data which is to be sequentially stored."

Furthermore, claim 6 also requires the following:

A generating section which, on the basis of results of detection of the detecting section, generates detection data regarding the difference between the data stored at the storage layer and the new data which is to be subsequently stored, and generates indication information which corresponds to the difference.

Even if, arguendo, the cited portion of col. 6 of Anderson '586 disclosed detecting a difference between storage data and new data, Anderson '586 would still fail to disclose generating "detection data regarding the difference" or generating "indication information which corresponds to the difference."

Fundamentally, the disclosure of Anderson '586 does not appear to go beyond writing new data to a data side of an optical disk, and subsequently marking the disk based on the current data on the data side of the optical disk. Anderson '586, therefore, does not disclose or necessitate determining a difference between stored data and new data, and fails to disclose

generating detection data regarding the difference, or indication information which corresponds to the difference.

Thus, Anderson '205 and Anderson '586, alone or in combination, fail to teach or suggest each and every required element of independent claim 6. These references, therefore, fail to render claim 6 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 6 and its dependent claims 7, 9, 10, 14 and 15.

Moreover, independent claim 16 recites features similar to those of independent claim 6. Claim 16 is, therefore, also patentable at least for reasons analogous to those presented above with respect to claim 6. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 16 and its dependent claims 17-19, and 21.

**Anderson '205 and Anderson '586 in view of Nakano**

Claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of Anderson '586 and further in view of Nakano. Applicant traverses this rejection for at least the following reasons.

Claims 8 and 20 depend from independent claims 6 and 16, respectively. The deficiencies of Anderson '586 with respect to independent claims 6 and 16 have been demonstrated above. Nakano, moreover, fails to make up for the above-described deficiencies, as Nakano is cited by the Examiner merely for its alleged teaching of an indication layer including electronic paper. Thus, Anderson '205, Anderson '586, and Nakano, alone or in combination, fail to teach or suggest each and every element of claims 8 and 20. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.



***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

This Amendment is being filed via the USPTO Electronic Filing System (EFS). Applicant herewith petitions the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

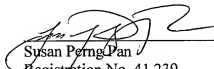
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

  
Susan Perng Pan  
Registration No. 41,239

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